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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,493	11/28/2000	Charles J. Torborg	EE-083-US-01	6977

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5X

Office Action Summary	Application No.		Applicant(s)	
	09/724,493		TORBORG ET AL.	
	Examiner		Art Unit	
	Margaret G. Moore		1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 37 is/are pending in the application.
- 4a) Of the above claim(s) 11 to 13, 28 to 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 10, 14 to 27, 32 to 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election of Group I, the carboxyl group containing polyester resins having an acid number of from about 25 to 250 species, in the reply filed on 8/24/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Currently claims 1 to 10, 14 to 27 and 32 to 37 are under consideration.

2. For the record, note that the claims are drawn to a composition which comprises the two components. These components can be in admixture with one another. Thus, considering claim 2, for instance, a catalyst in admixture with all of the components will meet this claim requirement. The catalyst need not be separated from component b) to anticipate this claim.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 to 10, 14 to 27 and 32 to 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15 to 30 of copending Application No. 09/724,490. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '490 require a powder coating composition that embraces that claimed. While the coating composition required in claim 19 of '490 does not specifically include a

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carboxyl group containing material, such a material is embraced by the claimed composition, as can be seen from claim 20 in '490 which requires a carboxyl group containing material. Applicants' elected species is found in claim 22 of '490. The catalyst of instant claims 2 - 4, 14 and 15 is found in claims 17 and 18 of '490. The crosslinker and curing agents in claims 5 and 24 are found in claim 16. The ratios in claims 21 and 23 are in claims 28 and 29 in '490. Adjusting the amount of each component in the composition in '490 would have been within routine experimentation for the skilled artisan and as such claims 6 to 8 are obvious over '490. The gloss levels in claims 16, 17, 32 and 36 are found in claim 26 of '490. Adjusting the particle size of the powder coating in '490 would have been within routine experimentation and/or optimization, rendering obvious claims 25 to 27. The pencil hardness requirements in claims 19, 20, 34 and 37 will inherently be met by the composition in '490 since the compositions themselves are the same. Note that the substrates in claims 32 to 37 are met by the wood in '490.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5 - 10, 16 - 20, 24 - 27 and 32 - 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Decker et al.

Decker et al. teach epoxy functional acrylic powder coatings. Column 2, lines 15 to 25, teaches an epoxy acrylic resin corresponding to (i), including the epoxide equivalent weight and Tg requirements of claims 1 and 16. Column 2, lines 35 to 40, teach a carboxyl group containing polyester corresponding to b), including the acid number requirement of claims 1 and 10. Line 29 of column 2 teaches that this polymer is heterogeneous, meeting the "not substantially compatible" requirement in claim 1. Column 3, lines 52 to 58, teach the curing agent (ii), including the specific compounds of claim 24. See for instance Table 3 which prepares such powder coating compositions, and meets the weight requirement of claims 6 to 8. These excerpts from Decker et al. clearly show that this reference anticipates the instant claims.

With regard to claims 25 to 27, see column 4, line 10.

With regard to claims 17 to 20, while the prior art is silent as to these properties, the Examiner notes that a composition and properties inherently associated therewith cannot be separated. Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Thus, if the prior art teaches the identical chemical composition, the properties applicants disclose and/or claim are necessarily present. Since the prior art composition is identical to that claimed, the inherent properties must be the same as well. As such it would appear that the powder coatings in Decker et al. inherently meet these property requirements.

For claims 32 to 35, the Examiner notes the inherency rationale detailed supra as it presently applies. Also note that the examples are applied to a steel substrate (see the bottom of column 6).

8. Claims 2 to 4, 14, 15 and 21 to 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decker et al.

Regarding claims 2 to 4, 14 and 15, the Examiner notes that Decker et al. do not

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specifically include a catalyst in this powder coating composition. However it is prima facie obvious to add a known compound to a composition to obtain the known benefits and properties thereof. It is quite well known to add a catalyst, particularly those in claims 14 and 15, to epoxy curing powder coating compositions in an effort to improve and/or increase curing. Note for instance Table 1 which shows prior art compositions that contain such a catalyst. As such the skilled artisan would have found the addition of a catalyst in the compositions of Decker et al. to have been obvious.

With regard to claims 21 to 23, the Examiner notes too that these ratios are not taught by Decker et al. However Decker et al. does use the polycarboxylic acid as a curative for the epoxy resin (column 3, lines 49 and 50) and the skilled artisan would realize that adjusting the amount of curative will directly affect the degree of curing. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). Also note that column 3, line 22, teaches that dicarboxylic acids and anhydrides can be used in the alternative. It is recognized that the anhydrides are the equivalents of acids, in which a molecule of water has been removed.

With regard to the gloss and pencil hardness requirements in claims 36 and 37, note the inherency rationale detailed supra.

9. Claims 1 - 5, 9, 10, 16 - 20, 24 - 27, 32 - 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Daly et al.

Daly teach low temperature curing powder coating compositions. The compositions contain glycidyl methacrylate copolymer in conjunction with a carboxylic acid polyester. A carboxylic acid component may also be added. See column 2, lines 10 to 34, column 3, lines 22 to 60, column 4, lines 20 to 35 and column 5, lines 22 to 34.

Particular attention is drawn to examples 9 to 12. This contains a material known as Ruco 911, a polyester having carboxyl groups and having an acid number within the claimed range (as taught on column 5, line 32) which meets the requirements of (b) and claims 9 and 10, a material known as GMA 300 or 252 which has an epoxy equivalent

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weight meeting that claimed and a Tg within the claimed range (as taught on column 4, line 32) which meets (i) and claim 16, and sebacic acid, which meets (ii) and claim 24. In this manner Daly et al. meet each of the claim limitations of claim 1, as well as claims 9, 10, 16 and 24. These examples contain various components that function as a cross-linker as well as an imidazoles crosslinking catalyst, meeting claims 2-5. The examples show a 60° gloss that meets claims 17, 18, 32 and 33. Column 6, line 53, teaches particle sizes meeting claims 25 and 27. For claim 35, see column 7, lines 10 to 17.

With regard to claims 19, 20 and 34, the Examiner notes that Daly et al. do not specifically teach pencil hardness; however, a composition and properties inherently associated therewith cannot be separated. Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Thus, if the prior art teaches the identical chemical composition, the properties applicants claim are necessarily present. Since the prior art composition is identical to that claimed, the inherent properties must be the same as well. As such it would appear that the powder coatings in Daly et al. inherently meet these property requirements.

10. Claims 21 to 23, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al.

With regard to the requirement in claims 21 and 23 that a dianhydride be used, note column 2, lines 25-30, which teaches that crystalline polycarboxylic acids and dianhydrides can be used in the alternative. Thus the use of sebacic dianhydride rather than sebacic acid would have been obvious. With regard to the curing agent ratio, the Examiner notes that acid groups in the dianhydride are used to cure with the epoxy groups. The skilled artisan would realize that adjusting the amount of curative will directly affect the degree of curing. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation).

With regard to claims 22 and 36, note that blooming is a property that will be inherently associated with the composition per se and since the composition is an

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obvious optimization of the teachings of Daly et al., such a property would appear to be inherently associated with this composition. Note for instance that Daly et al. teach the required gloss of claim 36. This rationale applies as well to claim 37.

11. Kulzick et al. is cited as being of general interest, as this teaches a powder coating composition containing polyester and epoxy resins. Kunze et al. is cited as being of general interest, as this also teaches a powder coating composition containing polyester and epoxy resins.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free):


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
12/26/04